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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. MANARD and SHIANG-YEE LEE

Appeal 2008-1781
Application 10/040,989
Technology Center 2600

Decided: September 24, 2008

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY,
and ELENI MANTIS MERCADER, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 1-3, 6-12, 15-18, and 21. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

Appellants' claimed invention is directed to operator interaction with a computer system via images on a display screen monitor of a computer (Spec. ¶[0001]). More particularly, color values of white (12) and black (14) squares are mapped to an offscreen action bitmap which associates color values with a program algorithm designed to perform an operator desired function (Figure 1 and Spec. ¶[0018]). The pixel color map operator interface eliminates the need for geographic mapping of a single bitmap (Spec. ¶[0018]).

Claim 1, reproduced below, is representative of the subject matter on appeal:

1. A computer system performing interactive commands, comprised of:
an input responsive to an operator action;
an output for performing a computer program function;
an operator graphical interface including a pixel color map supported on the computer system, displayed on a computer monitor display screen and being engaged by the operator via the input configured to selectively map at least one sensitive region on the display screen; and

wherein the at least one sensitive region is designated in the pixel color map without altering the pixel color map, the region associated with at least one pixel color value selected from the pixel color map currently displayed on the graphical interface which triggers the computer program function.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Bartok	US 5,737,553	Apr. 07, 1998
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The following rejection is before us for review:

1. Claims 10-12, 15, and 16 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Claims 1-3, 6-12, 15-18, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bartok.

WRITTEN DESCRIPTION

There is a single issue before us regarding whether Appellants have shown that the Examiner erred in rejecting claims 10-12, 15, and 16 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The issue is whether the introduced by amendment¹ claim limitation of “comparable color values” constitutes new matter unsupported by the originally filed disclosure.

FINDINGS OF FACT

The relevant facts include the following:

1. The Examiner found that “comparable color values” means color values in addition to shades of colors, such as different color spaces (i.e., RGB, CMY, YIQ, HSV, and HLS). The Examiner cited the extrinsic evidence of James D. Foley et al., *Computer Graphics Principles and Practice*, 2d ed. in C, July 1997, at 584-95. (Ans. 12).
2. The Examiner further found that “comparable color values” means color values in addition to shades of colors, such as different associations of colors (i.e., complimentary colors, analogous colors, triad colors). The Examiner cited the extrinsic evidence of Joan R. Truckenbrod, *Effective Use of Color in Computer Graphics*, Computer Graphics, Vol. 15, No. 3, Sec. 2.3 and 3.3 (Aug. 1981), at 83-90. The Examiner also cited the extrinsic evidence of <http://www.flood.com/Flood/DIY/IdealGallery/Trends/Color+Wheel+Color+Trends.htm> (last visited Sept. 18, 2008). (Ans. 13-14).

¹ Claim language of “comparable color values” was introduced by the Amendment dated 6/21/2006.

PRINCIPLES OF LAW

Under the written description portion of the first paragraph of 35 U.S.C. § 112, Appellants must convey with reasonable clarity to those skilled in the art that they had possession of the invention as of the filing date sought. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991); *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983).

ANALYSIS

Did the Examiner err in determining that the limitation of “comparable color values” is unsupported by the originally filed disclosure?

Appellants argue that the limitation of “different colors and shades of colors” is supported by the originally filed Specification because paragraph [0019] recites “different colors and shades of colors” (App. Br. 12). Appellants assert that “different colors and shades of colors” is synonymous to “comparable color values” (App. Br. 12).

The Examiner responds that the terms “comparable color values” means color values in addition to shades of colors, such as different color spaces (i.e., RGB, CMY, YIQ, HSV, and HLS) and such as different associations of color (i.e., complimentary colors, analogous colors, and triad colors), both meanings being unsupported by the originally filed Specification (Ans. 13 and Findings of Fact 1 and 2).

We agree with the Examiner’s findings of facts and conclusions as set out in the Answer and adopt them as our own. We further note that the Appellants have

not responded to the Examiner's assertions supported by the Extrinsic Evidence (Reply Br. 1-7).

Thus, Appellants' argument has not persuaded us of error in the Examiner's rejection of claims 10-12, 15, and 16 because "different colors and shades of colors" is not synonymous to "comparable color values" (Findings of Fact 1 and 2).

ANTICIPATION

Initially, we note that claims 1-3, 6-9, and 21 were argued as a group with claim 1 as representative (App. Br. 8-9).² Claims 10-12, 15, and 16 were also argued as a group with claim 10 as representative (App. Br. 9-11). With respect to this second grouping of claims, Appellants repeat the arguments set forth with regard to claims 1-3, 6-9, and 21 and present additional argument (App. Br. 9-11). Appellants repeat the same arguments for claims 17 and 18. Accordingly, we group claims 17 and 18 with claims 10-12, 15, and 16 as no additional arguments were presented (App. Br. 11-12).

There are two anticipation issues before us regarding whether Appellants have shown that the Examiner erred in rejecting claims 1-3, 6-12, 15-18, and 21 under 35 U.S.C. § 102(b).

² Only arguments made by Appellants have been considered in this decision. Arguments which Appellants could have made but did not make in the Briefs have not been considered and are deemed waived. See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

We present these issues as they correspond to, and in the order of, Appellants' presented arguments:

Claims 1-3, 6-9, and 21

The first issue is whether the Examiner erred in determining that Bartok teaches at least one sensitive region designated in the pixel color map without altering the pixel color map. The first issue turns on whether the claim language precludes user selection of at least one sensitive region during the assessing and execution steps. Furthermore, the first issue also turns on whether the additional steps of Bartok of selecting and painting a region are precluded by the claim language in view of the open-ended transitional term "comprising."

Claims 10-12 and 15-18

The second issue is whether the Examiner erred in determining that Bartok teaches mapping the pixel color map that comprises at least one color value "including regions physically separate from each other and discontinuous with the originally selected region" as claimed. The second issue turns on whether Bartok teaches the creation of discontinuous hotspots.

FINDINGS OF FACT

The relevant facts include the following:

1. Bartok teaches that the processor may read a pixel number and an associated unique color linked to a location on the screen of a display (col. 3, ll. 21-26).
2. Bartok further teaches that a user may click a mouse button while the cursor is positioned at a pixel within a hot spot object "to launch a functional object

mapped to a color, and selected by a user designating a pixel mapped to the color” (col. 3, ll. 27-35).

3. Bartok teaches that during the assessing step 334 and the execution process 336 the user selects at least one sensitive region (i.e., colored hot spot) that is designated in the pixel color map without altering the pixel color map (Fig. 7; col. 8, ll. 6-22 and col. 8, ll. 39-65).
4. Appellants’ figure (untitled) indicating the differences between Bartok and the current Application, shows that the only difference occurs during SETUP wherein Bartok includes the additional steps of selecting and painting a region prior to designating the colored region as a hotspot (untitled figure, Reply Br. 4).
5. Bartok teaches that in order to create one single pixel resolution discontinuous hot spots may be created (col. 7, ll. 61-65).
6. Bartok teaches that a hot spot 96 associated with any portion of the displayed image 60 may be discontinuous (col. 14, ll. 30-34).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. Inc., v. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim

language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

During ex parte prosecution, claims must be interpreted as broadly as their terms reasonably allow since Appellants have the ability during the administrative process to amend the claims to avoid the prior art. *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989).

Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

The transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited elements. *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997).

ANALYSIS

Claims 1-3, 6-9, and 21

a) Did the Examiner err in determining that Bartok teaches at least one sensitive region designated in the pixel color map without altering the pixel color map as claimed?

Appellants argue that Bartok does not teach the limitation of “the at least one sensitive region is designated in the pixel color map without altering the pixel color map” as recited in claim 1 (App. Br. 8). Appellants assert that Bartok paints the hotspot objects unique colors after they are

created, and, thus, the hotspot objects depend on their position and shape rather than on their color (App. Br. 9).

The Examiner responds that Bartok may alter a color image 60 and associated color maps 102 and 104 (Fig. 4) during the image creation process steps (i.e., Fig. 7, steps 340-350), but, after the process is completed Bartok does not alter the color map when the image 60 is displayed as a pixel color map operator interface (i.e., Fig. 7, steps 352-362) (Ans. 11).

The Examiner further notes that this is similar to Appellants' own disclosure wherein a color map with positions and shapes is created corresponding to status indicators (i.e., toner levels or job complete status) allowing operator interaction with complex and sophisticated technologies through the intuitive nature of the images (Spec. [0025]) (Ans. 11).

Appellants counter argue that while both the present Application and Bartok use only color to look up and execute a computer function, the differences occur during the setup of the image (Reply Br. 4-5 addressing Figure in page 4 indicating differences in SETUP rather than END USE or execution).

We agree with the Examiner's findings of facts and conclusions as set out in the Answer. We add the following primarily for emphasis.

First, we note that nothing in the claims designates that the steps are those occurring during the SETUP or END USE phase, and as stated *supra*, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d at 1184.

Claim 1 recites that “the at least one sensitive region is designated in the pixel color map without altering the pixel color map.” Bartok teaches that the processor may read a pixel number and an associated unique color linked to a location on the screen of a display (Finding of Fact 1). Bartok further teaches that a user may click a mouse button while the cursor is positioned at a pixel within a hot spot object “to launch a functional object mapped to a color, and selected by a user designating a pixel mapped to the color” (Finding of Fact 2). During the assessing step 334 and the execution process 336 the user selects at least one sensitive region (i.e., colored hot spot) that is designated in the pixel color map without altering the pixel color map (Finding of Fact 3). In other words, when the user selects a colored object on the screen of the display, the pixel color map does not change colors.

Furthermore, as indicated by Appellants’ figure (untitled) indicating the differences between Bartok and the current Application, the only difference occurs during SETUP wherein Bartok includes the additional steps of selecting and painting a region prior to designating the colored region as a hotspot (Finding of Fact 4). As stated *supra*, the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited elements such as selecting and painting a region prior to designating the region color as a hotspot. *Genentech, Inc. v. Chiron Corp.*, 112 F.3d at 501.

Thus, Appellants’ argument has not persuaded us of error in the Examiner’s rejection of claims 1-3, 6-9, and 21 because the claim language does not preclude user selection of at least one sensitive region (colored hot spot) which is designated in the pixel color map without altering the pixel

color map during the assessing and execution steps (Findings of Fact 1-3). Furthermore, the claim language does not preclude selecting and painting a region prior to designating the colored region as a hotspot due to the use of the open-ended transitional term “comprising” (Finding of Fact 4).

Claims 10-12 and 15-18

b) Did the Examiner err in determining that Bartok teaches mapping the pixel color map that comprises at least one color value “including regions physically separate from each other and discontinuous with the originally selected region” as claimed ?

Appellants repeat the argument made under section a) of the analysis (App. Br. 9-10). We direct Appellants to the analysis *supra* regarding these arguments. Appellants further argue that Bartok does not teach discontinuing hotspots because Bartok states that each defined region receives a unique color, and, thus, it is impossible to give a second region the same color because then it would not be unique (Appeal Br. 10 and col. 8, ll. 59-61).

The Examiner responds that Bartok teaches discontinuous hotspots (Ans. 12 and citing col. 7, ll. 62-65).

We agree with the Examiner’s findings of facts and conclusions as set out in the Answer and adopt them as our own. We add the following primarily for emphasis.

Bartok teaches creating one single pixel resolution by using discontinuous hot spots (Finding of Fact 5). Furthermore, Bartok teaches that a hot spot 96 associated with *any portion of the displayed image 60* may be discontinuous (Finding of Fact 6) (emphasis added).

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Thus, Appellants' argument has not persuaded us of error in the Examiner's rejection of claims 10-12 and 15-18 because Bartok teaches the creation of discontinuous hotspots (Findings of Fact 5 and 6).

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 10-12, 15, and 16 under 35 U.S.C. § 112, first paragraph. We further conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-3, 6-12, 15-18, and 21 under 35 U.S.C. § 102(b).

ORDER

The decision of the Examiner to reject claims 1-3, 6-12, 15-18, and 21 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

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